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LU'ONG, ALAN H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,336

Applicant(s)

BLACQUIERE ET AL.

Examiner

ALAN LUONG

Art Unit

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 9-13 and 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. 6,243,353 to Nozaki et al., in view of US Pat. 5,867,205 to Harrison, further in view of US Pat. 6,216,264 to Maze et al.

Regarding claim 1: Fig. 1 of Nozaki illustrates a **system of a recordable medium [100] and a recording apparatus for recording programs on the recordable medium, and the recording apparatus** comprising:

Referring to Fig. 1, **a receiver** [i.e. an input 107 and a tuner 108] **for receiving receivable programs** (i.e. *the video and audio signals*) (Nozaki, col. 4 lines 19-53) (*an input 107 and a tuner 108 receive the video and audio signals supplying to the encoding unit [104] where converts the received signal into the digital video and audio signals by converter 201 and packeted by [205] to pack for recording*)

However, Nozaki fails to teach *the recordable medium comprising a pre-recorded search instruction and a comparator for comparing the pre-recorded search instruction on the recordable medium with program information on the receivable programs.*

In an analogous art directed toward a similar problem namely improving the results from *a pre-recorded search instruction and a comparator for comparing the pre-recorded*

search instruction on the recordable medium with program information on the receivable programs.

Fig. 3 of Harrison illustrates [260] as **the recordable medium comprising a pre-recorded search instruction** (i.e. user's profile information is stored in a profile unit [260]) (Harrison, Fig. 3, col. 3 lines 32-36, col. 4 lines 23-col. 5 line 6). Referring to Fig. 2, a **comparator [250] for comparing the pre-recorded search instruction on the recordable medium with program information on the receivable programs** (Harrison, col. 4 lines 6-22, col. 6 lines 25-36). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to *modify the recordable medium of Nozaki with a pre-recorded search instruction and comparator as taught by Harrison in order to determine if channel contents of the channels are among channel contents defined by selection data for automatic recording.* (Harrison, Abstract)

However, Harrison does not teach *means for recording a particular one of the receivable programs on the recordable medium only if the particular one of the receivable programs matches the pre-recorded search instruction.*

In an analogous art directed toward a similar problem namely improving the results from matching the pre-recorded search instruction. Fig. 7 of Maze illustrates the Gopher program wherein ***means for recording*** (as VCR 402 of Fig. 4) ***a particular one of the receivable programs on the recordable medium only if the particular one of the receivable programs*** (i.e. the Program Guide data is acquired) ***matches the pre-***

recorded search instruction (i.e. the search terms are retrieved from user search request). (*Maze*, col. 5 lines 30-45).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify a recording apparatus of Nozaki and Harrison with a matching the pre-recorded search instruction as taught by Maze to provide user searching the listing for specific user-entered information as a search of the text for a particular text string which may relate to the title, the star, the director, or the context of the program, among other search criteria for scheduling the TV programs (Abstract).

Regarding claim 2: The system as claimed in claim 1, Harrison teaches wherein the **pre-recorded search instruction to be recorded on the recordable medium** (Harrison, Fig. 3, col. 3 lines 32-36, col. 4 lines 23-col. 5 line 6) and Maze also teaches "wherein the pre-recorded search instruction comprises **an indication of a specific type of program** to be recorded on the recordable medium"; (*Maze*, col. 3 line 67 to col. 4 line 10).

Regarding claim 3: merely repeats the limitation of claim 1. So, claim 3 has the same ground rejection as claim 1 and is anticipated by Nozaki, Harrison and Maze. (See discussion in claim 1)

Regarding claim 4: The recording apparatus as claimed in claim 3, Fig. 2, 3 of Maze shows "wherein the pre-recorded search instruction comprises **an indication of a specific type of program** (i.e. search term "ZULU" as movie title and "MICHEAL CAIN"

as movie star) **to be recorded on the recordable medium**"; (Maze, col. 2 line 48 to col. 3 line 20).

Regarding claim 5: The recording apparatus as claimed in claim 4, Fig. 1a-1c of Maze shows further comprising **"an information receiver for receiving the program information indicating a type and times of occurrence of the receivable programs to supply the program information on receivable programs to the comparator (Maze, col. 2 lines 27-47)** *(Example: the search term "HOME" has been entered by a user; the screen display of FIG. 1b shows a television program on channel 106 entitled "HOME IMPROVEMENT" is now highlighted at the time between 7:00 -7:30pm. If desired, a further search can be initiated by pressing the MENU key again. The screen display of FIG. 1c depicts a television program on channel 305, "HOME AND GARDEN" is highlighted at the time between 8:00 -8:30pm, because that title includes the word "HOME", and thus satisfies the search criteria. The subject apparatus can also perform "substring searching" wherein the keyword (search term) is contained within another word. For example, a substring search on the word HOME would find the movie title "HOMEWARD BOUND".).*

Regarding claim 6: The recording apparatus as claimed in claim 5, Harrison also teaches **wherein the information receiver inputs the text signal into a teletext receiver** (i.e. Closed Caption associated with video signal) **for scanning teletext pages containing the program information on receivable programs (Harrison, col. 3 line 58 to col. 4 line 22).**

Regarding claim 9: The recording apparatus as claimed in claim 3, Harrison teaches **wherein the programs are TV-broadcast programs (Harrison, col. 3 lines 47- 58),** and Nozaki also teaches **wherein the recording apparatus is a recorder for recording programs on an optical medium (Nozaki, col. 3 lines 61-63) .**

Regarding claim 10: The recording apparatus as claimed in claim 3, and Nozaki also teaches *wherein the recording apparatus is a DVD-recorder (Nozaki, col. 10 lines 60-61).*

Regarding claim 11: The system as claimed in claim 1, claim 11 merely repeats the same features as claim 1. Nozaki, Harrison and Maze disclose all limitations of claim 1. Therefore, claim 11 is anticipated by Nozaki, Harrison and Maze. Nozaki also teaches *"the recording apparatus further comprises **a storage medium** [optical disk 100] and the recordable medium is a removable recordable medium (a DVD disk in the case of a recording/playback DVD apparatus is removable recordable disk) (Nozaki, col. 10 lines 60-61).*

Regarding claim 12: The recordable medium for use in the system of claim 1, Harrison teaches **the recordable medium comprising a pre-recorded search instruction** (i.e. user's profile information is stored in a profile unit [260]) (Harrison, Fig. 3, col. 3 lines 32-36, col. 4 lines 23-col. 5 line 6)

Regarding claim 13: The recordable medium of claim 12, merely repeats the limitation of claim 2. So, claim 13 has the same ground rejection as claim 2. (See discussion in claim 2)

Regarding claim 16: The method of recording programs on a recordable medium has the same limitation of claim 1. Claim 16 has the same ground rejection of claim 1.

Regarding claim 17: A method as claimed in claim 16, claim 17 has the same limitation of claims 12 and 13. So, claim 17 has the same ground rejection of claims 12 and 13 combination.

3. **Claims 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki, Harrison and Maze et al.; in view of US 2003/0204848 A1 published by David J. Cheng et al. (hereinafter Cheng)

Regarding claim 7: The recording apparatus as claimed in claim 3, Nozaki, Harrison and Maze references are deficiency with *"where the recording apparatus comprising a controller for checking whether a still free space on the recordable medium is sufficient to record the receivable program matching the specific type of program, for causing the recording means to record the program matching in the free space, if sufficient, or for causing the recording means to delete at least one already recorded program to free sufficient space to record the program matching the specific type of the programs"*.

In an analogous art directed toward a similar problem namely improving the results from free space on the recordable medium for recording , Cheng teaches a recording device" further comprising a controller for checking whether a still free space on the recordable medium is sufficient to record the receivable program matching the specific type of program, to record the program matching in the free space, if sufficient, or to delete at

least one already recorded program to free sufficient space to record the program matching". (**Cheng, ¶0052, ¶0054, ¶0055**)

Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify Nozaki, Harrison and Maze references with a recording process system as taught by Cheng to delete at least one already recorded program to free sufficient space to record the program matching".

Regarding claim 8: The recording apparatus as claimed in claim 7, Cheng also teaches a series record event [226] is scheduled the recording device to record each episode of "the already recorded program", the series record event 226 "comprises a recorded program recorded earliest". (**Cheng, ¶0033**)

4. Claims 14, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki, Harrison and Maze et al., in view of US 2003/0012562 A1 published by Nabil M. Lawandy et al. (hereinafter Lawandy).

Regarding claim 14: The recordable medium as claimed in claim 12, neither Harrison nor Maze teaches "wherein the recordable medium further comprises a visible marking indicating the pre-recorded search instruction".

In an analogous art directed toward a similar problem namely improving the results from a visible marking indicator; Lawandy teaches "a visible marking indicator" [432] as marking for "the pre-recorded search instruction" (**Lawandy, ¶0088**). Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify Nozaki, Harrison and Maze references with a visible

marking as taught by Lawandy to provide enhanced identification, authentication and encoding capabilities for various articles of manufacture, including media containing optically readable information. More specifically, a need exists to rapidly produce images, text, or other optically encoded information on the read side of optical media. Further more, the method should not interfere with the performance of data readout from the optical media. (**¶0015**)

Regarding claim 15: The recordable medium as claimed in claim 13, neither Harrison nor Maze teaches "wherein the visible marking comprises a text and/or image label indicating the specific type of program to be recorded."

In an analogous art directed toward a similar problem namely improving the results from a visible marking indicator; Lawandy teaches "a visible marking indicator" [432] as marking for a text and/or image label indicating the specific type of program to be recorded." (**Lawandy, ¶0054, ¶0098**). Therefore, it would have been obvious to someone having ordinary skill in the art at the time of the invention was made to modify Nozaki, Harrison and Maze references with a visible marking as taught by Lawandy to provide a need exists to rapidly produce images, text, or other optically encoded information on the read side of optical media. Further more, the method should not interfere with the performance of data readout from the optical media. (**¶0015**)

Response to Arguments

5. Applicant's arguments filed 21 May 2009 have been fully considered but they are not persuasive.

A. Applicants submit that Harrison fails to disclose the recordable medium comprising a pre-recorded search instruction, Harrison merely gives a detailed description of the sections of the profile unit and the data being stored therein. However, there is no disclosure that the profile unit 260 is part of or pre-recorded on the recordable medium. (Remark; pages 7-8). Examiner respectfully disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In here; Harrison disclosure that the profile unit 260 equates **the recordable medium** (as disclosed in *Nozaki et al. reference*) wherein comprises a priority storage location that stores priority data programmed by the user to prioritize each channel been monitored by searching result. When the priority data is set, channels with a high priority will always pre-empt channels with a lower priority in the display/record unit. **(col. 4 lines 23-29)** as the **pre-recorded search instruction**. The user programs specifies items of interest that are monitored by the analyzing unit 250 for each channel. Once the analyzing unit 250 detects the trigger text, the analyzing unit 250 reads the action storage location to determine what action to take for recording or displaying on display/record unit. **(col. 4 lines 44-52)**. Therefore, combination of *Nozaki et al.* and *Harrison references* disclose the recordable medium comprising a pre-recorded search instruction.

B. Additionally, Applicants submit that Cheng et al. does not supply that which is missing from Nozaki et al., Harrison and Maze as cited in claim 7. (Remark; page 9). Examiner respectfully disagrees.

With above the same argument, combination of Nozaki et al., Harrison and Maze, Cheng modifies that "A conflict can also arise when the recording device does not have **sufficient storage space** to accommodate future record events; for ensuring that there is sufficient storage space to accommodate scheduled events, it is necessary to delete some of the recorded events or programs from the storage of the recording device in these situations; (**¶0052**). Additionally, the system first **determines that there is not sufficient storage space to record a program**. Next, it is necessary **to estimate how much storage will be required for the program being recorded** ;(**¶0054**), furthermore, another mechanism for **freeing storage space** is to use the priority manager. In this example, the priority manager can be used to prioritize recorded programs for potential deletion;(**¶0055**) meets the limitation of "*where the recording apparatus comprising a controller for checking whether a still free space on the recordable medium is sufficient to record the receivable program matching the specific type of program, for causing the recording means to record the program matching in the free space, if sufficient, or for causing the recording means to delete at least one already recorded program to free sufficient space to record the program matching the specific type of the programs*" which is missing from Nozaki et al., Harrison and Maze as cited in claim 7.

C. Applicants submit that while Lawandy et al. discloses a record carrier containing "markings", there is no disclosure or suggestion that these markings comprise the pre-recorded search instructions, as explicitly claimed in claim 14. (Remark; page 10). Examiner respectfully disagrees.

As above discussion, combination of Nozaki et al., Harrison and Maze, in view of Lawandy discloses a record carrier containing "markings" where these markings comprise the pre-recorded search instructions.

Examiner respectfully recognizes Applicant's position, however, it is respectfully submitted that a prima facie case of obviousness has in fact been established and the rejection should be sustained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN LUONG whose telephone number is (571)270-5091. The examiner can normally be reached on Mon.-Thurs., 8:00am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ALAN LUONG/
Examiner, Art Unit 2427

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427